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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,945	03/09/2004	Shinichi Imade	02257C/LH	4487
1933	7590	04/12/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC			LE, UYEN CHAU N	
767 THIRD AVENUE			ART UNIT	
25TH FLOOR			PAPER NUMBER	
NEW YORK, NY 10017-2023			2876	

DATE MAILED: 04/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4.9

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/796,945	IMADE ET AL.	
	Examiner	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Prelim. Amdt/Amendment***

1. Receipt is acknowledged of the Amendment filed 12 January 2005.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 38-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Philyaw in view of Wilz, Sr. et al (US 5,992,752).

Re claims 38-47: Philyaw discloses a printed matter 1602 (fig. 16) comprising: a first set of information 1604 containing at least one of characters, signs, graphics, painted pictures, photographic pictures and computer readable; and graphic printed in a form of visually; second set of information 1606 obtained by coding data and printed in a form of a coded image (fig. 16) optically readable to a reading device 1600, wherein: the coded image 1606 further includes: output control information for making an output unit of an access device (e.g., PC 302) output information for necessary inputting of instructions for causing the access device 302 to perform a sequence of operations accessing an external information resource (e.g., e-commerce site 1618, distributor site 1616, advertiser site 312, etc.), obtaining a third set of information (e.g., a new soft drink; or a competing item product Y) different from said first and second sets of information from the external information resource (col. 17, lines 23-45) and making the output unit (e.g., display 1612) outputs the obtained third set of information in a perceivable form at the

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time operation of the reading device 1600 optically reading out the coded image 1606 (col. 16, lines 16+), restoring/converting the second set and making the output unit information from the read out coded image access device 302 adapted to access the external information resource by way of a telecommunication network 306 to output the restored second set of information in a perceivable form (e.g., a soda; or the request information of product X) (col. 16, line 42 through col. 17, line 45); wherein, when the output unit comprises an image display unit 1612, the information for inputting instructions necessary for the operations is provided in a form of an image (col. 15, lines 57-59) through which instructions necessary for causing the access device 302 to perform the sequence of operations are input; wherein the information for inputting instructions necessary for the operation provided in the form of the image comprises a link icon (e.g., the barcode image 1606 is a link) (col. 16, lines 23+); wherein, when the output unit comprises a sound output unit, the information for inputting instructions necessary for the operations is provided in a form of sound with which instructions necessary for causing the access device 302 to perform the sequence of operations are input (figs. 1-3; col. 5, line 4 through col. 7, line 20); wherein the third set of information corresponds to the second set of information (e.g., a new soft drink corresponds to a soda; a competing product Y corresponds to a product X, etc.) (col. 17, lines 37-45); wherein the first set of information is basic information and the second set of information is detailed information relating to the basic information (e.g., the first set of information is product X; the second set of information is the requested/detailed information of the product X) (col. 17, lines 40+); a micro-controller 1700, which is a control unit for outputting the restored second set of information in a form perceivable from the output

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unit and also the information for inputting instructions necessary for the above operations on the basis of the restored output control information from the output unit (col. 18, lines 9-55).

Philyaw fails to teach or fairly suggest a user has inputted the operation instructions to acquire third information different from the first and second information.

Wilz, Sr. et al teaches a user clicks on one of the links display on the screen (fig. 4) to go from website 1 to website 2, etc. (fig. 5) to get information different from the first and second information (i.e., information display on the screen in fig. 4).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Wilz, Sr. et al into the system of Philyaw et al in order to provide the user with the flexibility in obtaining desired information, and therefore an obvious expedient.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-37 have been considered but are moot in view of the new ground(s) of rejection.

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a coded image is read from printed matter that includes first information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon, Wed. and Fri. 5:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



*Uyen-Chau N. Le*  
April 04, 2005



**THIEN M. LE**  
**PRIMARY EXAMINER**